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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,513	01/07/2005	Mario Polegato Moretti	264325US6PCT	5466
22850	7590	12/17/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
KAVANAUGH, JOHN T				
ART UNIT		PAPER NUMBER		
3728				
NOTIFICATION DATE		DELIVERY MODE		
12/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/520,513

Applicant(s)

MORETTI ET AL

Examiner

/Ted Kavanaugh/

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2008 has been entered.

Claim Rejections - 35 USC § 112

2. Claims 8-10,12,14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 8, line 13, the phrase "in a single molding step" is new matter. In claim 12, line 7, the phrase "in a single molding" is new matter. In claim 14, line 8, the phrase "in a single molding" is new matter. No where in the original disclose does it teach a single molding step or a single mold is used. It is clear that molding is involved but the disclose is silent with respect the particulars of the actual molding steps (i.e. such as steps of heating, pressure, and other characteristics of molding).

3. Claims 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 8 with tread (15) now formed as a single piece with the border (17), as shown in figure 1. Therefore, claim 8 and the other independent claims which have similarly been amended are no longer generic inasmuch as they just read on the embodiment shown in figure 1. Claim 10 is now indefinite inasmuch as it claims a perimetric element (117) as a separate preassembled insert comprising a perimetric element (the embodiment shown in figure 2) or its a double recitation of the "border" claimed in claim 8.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5983524 (Polegato) in view of the prior art admitted on page 5, line 16 to page 6, line 2.

Polegato teaches a waterproof and breathable sole (see figure 9) including a tread member (503) including a border and/or a perimetric element (the upper flange portions of the tread 503) and a midsole component comprising a lower protective layer (516), and a membrane (515) wherein the membrane and the protective layer are joined

by spot gluing; see col. 3, lines 11-15. Polegato lacks the spot gluing being a thermoreactive adhesive. Applicant teaches in the specification (see page 5, line 16, to page 6, line 2) that a thermoreactive adhesive is known. Such an adhesive is used to provide a stronger bond between layers; see page 5, lines 24-26. Therefore, it would have been obvious for the adhesive (glue) of Polegato to be a thermoreactive adhesive to provide a stronger bond between the layers. Figure 9 was sighted above but all of the other embodiments also have a tread and a midsole component has a membrane and lower protective layer. The method of making and the method of joining in claims 14 and 12, respectively, do not add any further limitations to the claims. The method steps follow the obvious method of assembling the waterproof and breathable sole for footwear as taught above. With regard to a single mold being used, a single mold (520) is used to construct the tread and border; see col. 6, lines 55-63.

Response to Arguments

6. Applicant's arguments filed 12/2/2008 along with the translation provided have been fully considered and are found persuasive. Therefore the objection to the amendment filed Nov. 19, 2007 have been withdrawn.
7. Applicant's remaining arguments filed 12/2/2008 have been fully considered but they are not persuasive.

Applicant argues the office action fails to cite to any specific teachings within either reference to support the applied combination.

To the contrary, see page 5, lines 24-26 in the instant specification wherein it teaches the thermoreactive adhesive provides a stronger bond between layers.

Applicant argues that the "thermoreactive adhesive" is from the medical field and thus the shoes as taught by Polegato are from a different field far from each other.

In response, the admitted prior art from the specification is being be used as it teaching of providing a better adhesive to obtain a stronger bond. Merely substituting one adhesive for a better adhesive would provide a benefit to the shoe of Polegato. Therefore, the combination would provide a predictable result.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to the tread and border now being a single piece, a new rejection has been applied. Figure 9 of Polegato has now been applied instead of figure 12 in view of applicant's amendment.

Conclusion

8. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

Art Unit: 3728

--**"A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."**

-Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Art Unit: 3728

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
December 15, 2008